



PATENT
Attorney Docket No. 018842.1285

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Int'l Patent Application of:)
Kiyoshi TERAUCHI et al.)
Application No.: 10/730,942) Examiner Michael S. LESLIE
Filed: December 10, 2003) Group Art Unit 3745
For: SWASH-PLATE COMPRESSOR) Confirmation No 6287
HAVING A PISTON IN WHICH A)
CONTACT SURFACE TO BE)
CONTACTED WITH A SHOE IS)
CONTINUOUSLY AND)
EXTENSIVELY FORMED)

REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants are submitting the following remarks with a Pre-Appeal Brief Request for Review in accordance with the Official Gazette Notice of July 12, 2005, and the Extension of Pre-Appeal Brief Conference Program, dated January 10, 2006. Applicants are filing this Request concurrently with a Notice of Appeal. Applicants respectfully request that the Panel of Examiners (the "Panel") reconsider the above-captioned patent application in view of the following remarks.

Remarks:

1. Rejections

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by Patent No. US 6,467,296 B2 to Fujii et al. (“Fujii”). Applicants respectfully disagree.

2. 35 U.S.C. § 102(b)

Claims 1, 2, 4, and 5 stand rejected as allegedly being anticipated by Fujii. “A claim is anticipated if and only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131. The Office Action alleges that Fujii describes each and every element as set forth in claims 1, 2, 4, and 5. Applicants respectfully disagree.

Applicants’ independent claim 1 recites “the contact surfaces are continuously formed between the engaging portions through the side wall portion.” The Office Action does not cite to any portion of the written description of Fujii that discloses this limitation of independent claim 1. Nevertheless, the Office Action asserts that Fuji “appears to be capable of performing” the function of having a contact surface which “continuously is formed between the engaging portions through the side wall portion,” as set forth in independent claim 1. See, e.g., Office Action, Page 2, Line 12 (emphasis added.)

“Pictures and drawings may be sufficiently enabling to put the public in the possession of the article pictured . . . however, the picture must show all of the claimed structural features and how they are put together.” MPEP 2121.04. Figure 2 of Fujii depicts a piston 26 which includes a semi-spherical recess 26a in which a semi-spherical shoe 24 is located. See, e.g., Fujii, Column 4, Lines 35-38. In Figure 2 of Fujii, there is a space between a portion of a

wall of recess 26a and an end of a swash plate. When piston 26 reciprocates between a top most position and a bottom most position, a first portion of shoe 24 moves towards the portion of the wall of recess 26a which has the space between it and the end of the swash plate. Similarly, when piston 26 reciprocates between the bottom most position and the top most position, a second portion of shoe 24 moves towards the portion of the wall of recess 26a which has the space between it and the end of the swash plate.

Nevertheless, as previously argued by Applicants in the above-captioned patent application, the Office Action has not shown that when piston 26 reciprocates between the top most position and the bottom most position, and vice versa, each any every portion of recess 26a at some point contacts shoe 24. For example, Applicants respectfully submit that the Office Action has not shown that piston 26 reciprocates, or is capable of reciprocating, far enough towards the top and far enough towards the bottom to allow shoe 24 to move in a path which covers recess 26 in it's entirety.

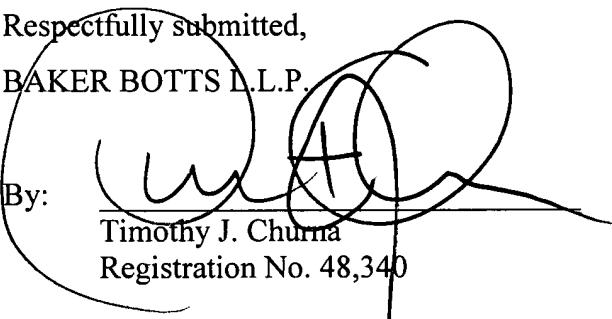
In response to Applicants argument, the Office Action asserts that Fujii “appears to be capable of performing” the function of having a contact surface which “continuously is formed between the engaging portions through the side wall portion,” as set forth in independent claim 1. See, e.g., Office Action, Page 2, Line 12 (emphasis added.) Fujii does not disclose a “continuously” formed contact surface extending between the engaging portion. Moreover, whether a prior art reference “appears to be capable of” performing in accordance with the claimed invention clearly is not the standard which the Office Action must satisfy in order to establish that the prior art reference anticipates the claimed invention. Instead, the Office Action must establish that Figure 2 of Fujii shows “all of the claimed structural features.” MPEP 2121.04 (emphasis added.)

In addition, Applicants respectfully submit that Figure 2 of Fujii merely is a cross-sectional diagram of a compressor. As such, Figure 2 of Fujii does not depict in sufficient detail which portions of recess 26a may be contact portions. Therefore, Applicants respectfully request that the Examiner withdraw the anticipation rejection of claim 1.

Claims 2, 4, and 5 depend from independent claim 1. Therefore, Applicants respectfully request that the Examiner also withdraw the anticipation rejection of claims 2, 4, and 5.

Conclusion:

Applicants respectfully submit that this application is in condition for allowance, and such disposition is earnestly solicited. In the event of any variance between the fees determined by Applicants and the fees determined by the U.S. Patent and Trademark Office, please charge or credit such variance to the undersigned's Deposit Account No. 02-0375.

Respectfully submitted,
BAKER BOTTS L.L.P.
By: 
Timothy J. Churna
Registration No. 48,340

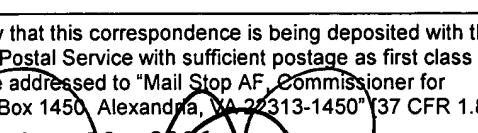
Dated: October 10, 2006

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | | | | | | | | | | | | |
| | | 018842.1285 | | | | | | | | | | | | |
| <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a))</p> <p>on <u>October 10, 2006</u></p> <p>Signature </p> <p>Typed or printed name <u>Timothy J. Churna</u></p> | | | | | | | | | | | | | | |
| <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 33.33%; padding: 5px;">Application Number</td> <td style="width: 33.33%; padding: 5px;">Filed</td> </tr> <tr> <td style="padding: 5px;">10/730,942</td> <td style="padding: 5px;">December 10, 2003</td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor</td> </tr> <tr> <td colspan="2" style="padding: 5px; text-align: center;">Kiyoshi Terauchi et al.</td> </tr> <tr> <td style="width: 50%; padding: 5px;">Art Unit</td> <td style="width: 50%; padding: 5px;">Examiner</td> </tr> <tr> <td style="padding: 5px;">3745</td> <td style="padding: 5px;">Michael S. Leslie</td> </tr> </table> | | | Application Number | Filed | 10/730,942 | December 10, 2003 | First Named Inventor | | Kiyoshi Terauchi et al. | | Art Unit | Examiner | 3745 | Michael S. Leslie |
| Application Number | Filed | | | | | | | | | | | | | |
| 10/730,942 | December 10, 2003 | | | | | | | | | | | | | |
| First Named Inventor | | | | | | | | | | | | | | |
| Kiyoshi Terauchi et al. | | | | | | | | | | | | | | |
| Art Unit | Examiner | | | | | | | | | | | | | |
| 3745 | Michael S. Leslie | | | | | | | | | | | | | |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
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